REMARKS

In the Examiner's Communication of June 27, 2007, the Examiner states, "Applicants' assertion (response filed May 9, 2007, page 9) that applicants are not required to respond to the provision[al] obviousness [type] double patenting rejections (see the Office action mailed February 9, 2007, pages 4-6) is incorrect. See MPEP 714.02. Applicants have pointed to no authority for the deliberate non-response to provisional rejections."

MPEP 804(I)B explains provisional obviousness-type double patenting rejection between copending applications as follows:

> B. Between Copending Applications-Provisional Rejections
>
> Occasionally, the examiner becomes aware of two copending applications that were filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee, or that claim an invention resulting from activities undertaken within the scope of a joint research agreement as defined in 35 U.S.C. 103(c)(2) and (3), that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of applications (35 U.S.C. 122), the courts have sanctioned the practice of making applicant aware of the potential double patenting problem ***if*** one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting. *In re Mott,* 539 F.2d 1291, 190 USPQ 536 (CCPA 1976); *In re Wetterau,* 356 F.2d 556, 148 USPQ 499 (CCPA 1966). *The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.*
>
> The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in at least one of the applications. [Emphasis added.]

As explained in MPEP 804(I)B, the objective of making the provisional obviousness-type double patenting rejection between copending applications is for "making applicant aware of the potential double patenting problem ***if*** one of the applications became a patent." [*Id.* Emphasis added.] The obviousness-type double patenting rejection, which is *not* a provisional rejection, *does*

not in fact exist until "one of the applications became a patent." [*Id.*] Thus, Applicants are not required to act on a potential obviousness-type double patenting rejection until "one of the applications became a patent" when the potential obviousness-type double patenting rejection becomes a real obviousness-type double patenting rejection, though, an applicant can address the provisional obviousness-type double patenting rejection if she chooses to do so. [*Id.*] Thus, MPEP 804(I)B states, "The merits of such a provisional rejection ***can be*** addressed by both the applicant and the examiner without waiting for the first patent to issue." [*Id.* Emphasis added.] If it was mandatory for an applicant to respond to a provisional obviousness-type double patenting rejection, then MPEP 804(I)B would have used the phrase "shall be" or "should be" instead of "can be" in the above quoted statement. The meaning of "can" in English law means, "To be able to do something" or "To have permission (as often interpreted by courts);" while "shall" means, "Has a duty to; more broadly, is required to" as explained in *Black's Law Dictionary*, p.197 and 1379, Seventh Edition (1999).

There is further support in MPEP 804(I)B that MPEP 804(I)B does *not* mandate that an applicant must respond to a provisional obviousness-type double patenting rejection. Recognizing that an applicant is not required to respond on the merit to a provisional obviousness-type double patenting rejection, MPEP 804(I)B states:

> The "provisional" double patenting rejection *should* continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in at least one of the applications. [Emphasis added.]

Please note that in the above quoted statement, MPEP 804(I)B uses the word "should," not "can." In short, the obligation on the Examiner to continue to make the "provisional" double patenting rejection as long as there are conflicting claims in more than one application is mandatory, while the obligation on an applicant to respond to a "provisional" double patenting rejection is *not* mandatory. In short, the Amendment filed May 9, 2007, in totally is in accordance with MPEP 714.02.

In view of the above remarks, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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